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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/936,073	09/05/2001	Masashi Kumagai	Komatsu Case 254	7850

7590 04/17/2003
Flynn Thiel Boutell & Tanis
2026 Rambling Road
Kalamazoo, MI 49008-1699

EXAMINER

SAEED, KAMAL A

ART UNIT	PAPER NUMBER
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1626

DATE MAILED: 04/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/936,073	Applicant(s) KUMAGAI ET AL.	
	Examiner Kamal A Saeed	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) 2-6 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Paper No. 1 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

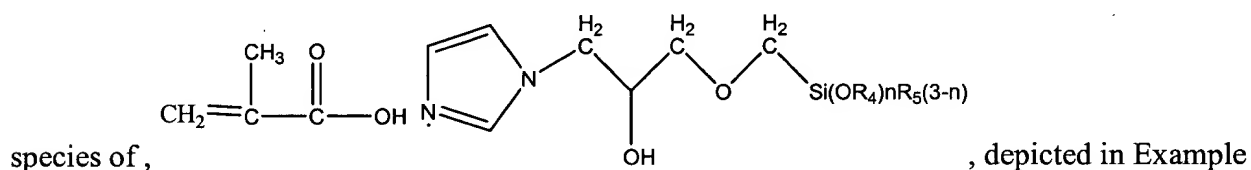
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|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>2</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-6 are currently pending in this application. claims 2-6 are withdrawn from further consideration by the Examiner, 37 C.F.R. § 1.142(b), as being drawn to a non-elected invention. The withdrawn subject matter is patentably distinct from the elected subject matter as it differs in structure and element and would require separate search considerations. In addition, a reference which anticipates one group would not render obvious the other. withdrawn subject matter is patentably distinct from the elected subject matter as it differs in structure and element and would require separate search considerations. In addition, a reference which anticipates one group would not render obvious the other.

Response to Restriction

In response to the restriction requirement, applicants' representative, Terrylene F. Chapman, in Paper No 5, filed on April 9, 2003, has elected with traverse the invention of Group I, claims 1, drawn to imidazole/organic monocarboxylic acid derivative reaction product, and the



1, page 13 of the specification, is acknowledged. The traversal is on the ground(s) that each of the elected species could be extended to other group without imposing an undue burden on the Examiner. This is not found persuasive because each of the various species are directed to art recognized compounds which are different from each other in structure and element and, are capable of supporting their own patents. Additionally, the fields of search are not co-extensive as they fall into multiple classes and subclasses (class 546, 548 and several subclasses) and the

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examiner is required to conduct a commercial data base search on the class and each subclass.

This would be an undue burden on the examiner.

In accordance with M.P.E.P. 821.04 and *In re Ochiai*, 71 F.3d 1565, 37 USPQ 1127 (Fed. Cir. 1995), rejoinder of product claim with one method of use and one process of making claim commensurate in scope with the allowed product claims will occur following a finding that the product claims are allowable. Until such time, a restriction between product claims, method of use and process of making is deemed proper.

Therefore, the restriction requirement deemed proper and is made FINAL.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Applicants preserve their right to file a divisional on the non-elected subject matter.

Status of the Claims

Claims 1-6 are pending in this application. Claims 2-6 are withdrawn from further consideration by the Examiner, 37 C.F.R. § 1.142(b), as being drawn to a non-elected invention. The withdrawn subject matter is patentably distinct from the elected subject matter as it differs in structure and element and would require separate search considerations. In addition, a reference which anticipates one group would not render obvious the other.

The generic concept of the elected subject matter is as follows:

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Compound of the Formula , depicted in page 8 of the specification, wherein R^1 , R^2 and R^3 each independently represent H, vinyl group or an alkyl group having 1-20 carbon atoms; R^2 and R^3 may together form an aromatic ring; R^4 and R^5 are each independently alkyl group having 1-5 carbon atoms; m and n are as defined; A is organic monocarboxylic acid.

As a result of the election and the corresponding generic concept identified supra, the remaining subject matter of claims 1 are withdrawn from further consideration pursuant to 37 CFR 1.142 (b) as being drawn to non-elected inventions. The withdrawn subject matter of claims 1 are properly restricted as it differs materially in structure and in element from the elected subject matter supra so as to be patentably distinct there from, i.e., a reference which anticipated but the elected subject matter would not even render obvious the withdrawn subject matter and the fields of search are not co-extensive.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

In *In re Wands*, 8 USPQ2d 1400 (1988), factors to be considered in determining whether a disclosure meets the enablement requirement of 35 U.S.C. § 112, first paragraph, have been described. They are:

1. the nature of the invention,
2. the state of the prior art,

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3. the predictability or lack thereof in the art,
4. the amount of direction or guidance present,
5. the presence or absence of working examples,
6. the breadth of the claims,
7. the quantity of experimentation needed, and
8. the level of the skill in the art.

A greater amount of evidentiary support is needed in order to fully satisfy the requirement of 35 USC 112, first paragraph, regarding sufficient guidance on “how to use” the invention. In the instant case, in claim 1, line 1, recites “ **organic monocarboxylic acid derivative**” with out any formula. This claim language is of broad scope that it reads a wide variety of **monocarboxylic acid derivatives** compounds that are heterocyclic, carbocyclic, aliphatic, etc many of which are neither enabled nor supported in the specification. Additionally, the **monocarboxylic acid derivatives** could have different substituents that are aliphatic, aromatic, carbocyclic, heterocyclic etc. A product is first classified by classifying the chemical compound which is prepared end product and then the process is searched based on the classification of the specific chemical compound. The specification does not give any guidance how to prepare **monocarboxylic acid derivatives** having all kinds of substituents. Applicant’s examples are directed to products that have only methacrylic acid salt groups. However, the claim is so broad that a skilled artisan would be faced with unlimited number of **monocarboxylic acid derivatives** that have unlimited number of substituents and it would require undue experimentation to make or use the invention. A suggestion to obviate the rejection would be to be to incorporate the formula of the **monocarboxylic acid derivatives** or to incorporate the general formula of the last product recited in page 8.

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Claim Objections

Claim 1 is objected to for containing non-elected subject matter. Claims drawn solely to the elected invention as identified supra, would appear allowable.

Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kamal Saeed whose telephone number is (703) 308-4592. The examiner can normally be reached on Monday-Friday from 8:00 AM – 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph K. McKane, can be reached at (703) 308 4537. The unofficial fax phone for this group are (703) 308-4556 or 305-3592.

When filing a FAX in Technology Center 1600, please indicate the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communications with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

Communication via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by applicant and should be addressed to [joseph.mckane@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees will not communicate with applicant via Internet e-mail where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified unless there is of record an express waiver of the confidentiality requirements under 35 U.S.C. 122 by the applicant. See the Interim Internet Usage Policy

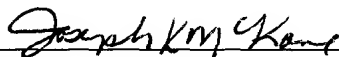
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published by the Patent and Trademark Office Official Gazette on February 25, 1997 at 1195 OG

89.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose telephone number is (703) 308-2286.

Kamal Saeed, Ph.D.,
April 15, 2003



Joseph K. McKane
Supervisory Patent Examiner
Art Unit 1626, Group 1620
Technology Center 1